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EXAMINER SWEARINGEN, JEFFREY R				
ART UNIT 2445		PAPER NUMBER		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/804,825

Applicant(s)

YAMASAKI ET AL.

Examiner

Jeffrey R. Swearingen

Art Unit

2445

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 November 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 4-10 and 33-39 is/are pending in the application.
- 4a) Of the above claim(s) 11-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4-10 and 33-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/ISA-93)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/2/09 has been entered.

Response to Arguments

2. Applicant's arguments with respect to claims 1, 4-10 and 33-39 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 8, 9 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. The term "in a state in which specific information cannot be accessed easily" in claims 1, 8, 9 and 10 is a relative term which renders the claim indefinite. The term "a state in which specific information cannot be accessed easily" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite

degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is impossible to construe Applicant's meaning of "cannot be accessed easily" based on a review of the specification. Additionally, Applicant has not defined what "specific information" is meant to encompass. The only reference to "specific information" is on page 93 of the originally filed specification, and relates to the encoding and subsequent processing of specific information, but inadequate intrinsic evidence is present within this portion of the specification for one of ordinary skill in the art to adequately determine Applicant's meaning of the term "a state in which specific information cannot be accessed easily".

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 4-10, and 33-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Motoyama et al. (6,631,247) in view of Patterson (US 7,127,515).

8. In regard to claim 1, Motoyama disclosed *an information communication device notifying a managing device of device information collected regarding a management target device by electric mail*, (Motoyama, column 6, lines 21-24, column 7, lines 16-30)) *said information communication device comprising: ...*

on-going selection of information being performed by the information selecting portion provided in the device and the selected information being sent. (Motoyama,

column 14, lines 21-40, status updates of whether data is urgent or non-urgent and should be transmitted)

Motoyama failed to disclose an information selecting section for selecting local to the target device which of the collected device information is to be converted into mail data and which of the collected device information is to be converted into attached data; and

a transmission processing section that converts the collected device information into both attached data and mail data, in accordance with the selection performed by the information selecting section, and, upon arrangement of the device information into attached data and email data, transmits a single electric mail containing both the attached data and the mail data to said managing device in a state in which specific information cannot be accessed easily;

However, Patterson disclosed an information selecting section for selecting local to the target device which of the collected device information is to be converted into mail data and which of the collected device information is to be converted into attached data; and Patterson transmitted the selected electronic content. The content may be transmitted as an e-mail attachment. Patterson, column 3, lines 42-54. Here, the mail data would be the data indicating the recipient of the email attached data, and the data to be transmitted is the e-mail attachment.

a transmission processing section that converts the collected device information into both attached data and mail data, in accordance with the selection performed by the information selecting section, and, upon arrangement of the device information into

attached data and email data, transmits a single electric mail containing both the attached data and the mail data to said managing device in a state in which specific information cannot be accessed easily; Patterson, column 3, lines 42-54. Patterson transmits an e-mail attachment to the recipient. The transmission of the e-mail attachment requires, in the same email, header and body data indicating the recipient of the information,—e.g. the mail data to said managing device. Because the e-mail is an attachment, it is not normally readable in a typical e-mail client without the use of a general e-mail plug-in, or the email attachment is by default *in a state in which specific information cannot be accessed easily*.

9. Motoyama failed to disclose a system where data was selected to be sent either as an email or as an attachment within the email. Motoyama did disclose how urgency was important in getting emails to the service provider. Motoyama, column 3, lines 1-7. Patterson disclosed that the use of the Patterson attachment system was ideal for reducing the burden and time required to process business requests for data during business hours. Patterson column 5, lines 27-39. It would have been obvious to one of ordinary skill in the art at the time of invention to use the Patterson email attachment system with Motoyama in order to expediently transmit the data from the business device in order to alert the manager of the copier problems, without experiencing transmission delays from normal business computer usage.

10. In regard to claim 4, Motoyama in view of Patterson disclosed:

said transmission processing section is set so as to convert use information indicating the state of use of said management target device into attached data.

Motoyama, column 14, lines 1-62, where data regarding the status of a device was sent via email to a managing device. The use of the Excel format in lines 16-20 taught the use of attachments, as also shown in column 17, lines 58-63.

11. In regard to claim 5, Motoyama in view of Patterson disclosed:

said transmission processing section is set so as to convert use information indicating the state of use of said management target device into attached data.

Motoyama, column 14, lines 1-62, where data regarding the status of a device was sent via email to a managing device. The use of the Excel format in lines 16-20 taught the use of attachments, as also shown in column 17, lines 58-63.

12. In regard to claim 5, Motoyama in view of Patterson further disclosed

said transmission processing section is set so as to transmit device information regarding a plurality of management target devices located in a predetermined area by a same electric mail. See Motoyama, column 14, lines 21-40, where multiple devices can transmit status information to a managing server.

13. In regard to claim 6 Motoyama in view of Patterson further disclosed

said transmission processing section is set so as to send the electric mail transmitted to the manager, also to another destination according to a request by a user. Motoyama disclosed that multiple persons such as home users were recipients of the status information messages. Column 14, lines 54-62.

14. In regard to claim 7, Motoyama in view of Patterson further disclosed

said transmission processing section includes an encoding section for encoding attached data, and is set so as to have the encoded attached data in an electric mail. In

column 14, Motoyama disclosed the *encoding* of data into a format such as Excel or HTML. In column 17, lines 58-63, Motoyama disclosed sending email with attachments present. The relationship of these attachments to the Excel or HTML formats being sent to a user in column 14 is inherent to Motoyama.

15. In regard to claim 8, Motoyama disclosed *a remote management system comprising: (Motoyama, column 6, lines 21-24, column 7, lines 16-30))*

an information communication device notifying a managing device of device information collected regarding a management target device by electric mail, (Motoyama, column 6, lines 21-24, column 7, lines 16-30)) ...

on-going selection of information being performed by the information selecting portion provided in the device and the selected information being sent; (Motoyama, column 14, lines 21-40, status updates of whether data is urgent or non-urgent and should be transmitted)

a management target device that causes said information communication device to transmit an electric mail containing device information; and Motoyama disclosed the transmission of status information for a device using email and attachments in column 14, lines 1-53, and column 17, lines 58-63.

a managing device that performs remote management of said management target device, based on the device information contained in the electric mail transmitted from said information communication device. Motoyama disclosed managing the device remotely via email commands in column 18, lines 39-62.

Motoyama failed to disclose an information selecting section for selecting local to the target device which of the collected device information is to be converted into mail data and which of the collected device information is to be converted into attached data; and

a transmission processing section that converts the collected device information into both attached data and mail data, in accordance with the selection performed by the information selecting section, and, upon arrangement of the device information into attached data and email data, transmits a single electric mail containing both the attached data and the mail data to said managing device in a state in which specific information cannot be accessed easily;

However, Patterson disclosed *an information selecting section for selecting local to the target device which of the collected device information is to be converted into mail data and which of the collected device information is to be converted into attached data; and* Patterson transmitted the selected electronic content. The content may be transmitted as an e-mail attachment. Patterson, column 3, lines 42-54. Here, the mail data would be the data indicating the recipient of the email attached data, and the data to be transmitted is the e-mail attachment.

a transmission processing section that converts the collected device information into both attached data and mail data, in accordance with the selection performed by the information selecting section, and, upon arrangement of the device information into attached data and email data, transmits a single electric mail containing both the attached data and the mail data to said managing device in a state in which specific

information cannot be accessed easily; Patterson, column 3, lines 42-54. Patterson transmits an e-mail attachment to the recipient. The transmission of the e-mail attachment requires, in the same email, header and body data indicating the recipient of the information,—e.g. the mail data to said managing device. Because the e-mail is an attachment, it is not normally readable in a typical e-mail client without the use of a general e-mail plug-in, or the email attachment is by default *in a state in which specific information cannot be accessed easily.*

16. Motoyama failed to disclose a system where data was selected to be sent either as an email or as an attachment within the email. Motoyama did disclose how urgency was important in getting emails to the service provider. Motoyama, column 3, lines 1-7. Patterson disclosed that the use of the Patterson attachment system was ideal for reducing the burden and time required to process business requests for data during business hours. Patterson column 5, lines 27-39. It would have been obvious to one of ordinary skill in the art at the time of invention to use the Patterson email attachment system with Motoyama in order to expediently transmit the data from the business device in order to alert the manager of the copier problems, without experiencing transmission delays from normal business computer usage.

17. In regard to claim 9, Motoyama disclosed *an information communication method for notifying a managing device of device information collected regarding a management target device by electric mail, said method comprising the steps of:* (Motoyama, column 6, lines 21-24, column 7, lines 16-30))

on-going selection of information being performed by the information selecting portion provided in the device and the selected information being sent. (Motoyama, column 14, lines 21-40, status updates of whether data is urgent or non-urgent and should be transmitted)

Motoyama failed to disclose selecting local to the target device which of the collected device information is to be converted into mail data and which of the collected data is to be converted into attached data;

converting the collected device information into both attached data and mail data, in accordance with said selecting; and

upon arrangement of the device information into attached data and email data, transmitting a single electric mail containing both the attached data and the mail data to said managing device in a state in which specific information cannot be accessed easily;

However, Patterson disclosed *selecting local to the target device which of the collected device information is to be converted into mail data and which of the collected data is to be converted into attached data*; Patterson transmitted the selected electronic content. The content may be transmitted as an e-mail attachment. Patterson, column 3, lines 42-54. Here, the mail data would be the data indicating the recipient of the email attached data, and the data to be transmitted is the e-mail attachment.

converting the collected device information into both attached data and mail data, in accordance with said selecting; and Patterson transmitted the selected electronic content. The content may be transmitted as an e-mail attachment. Patterson, column

3, lines 42-54. Here, the mail data would be the data indicating the recipient of the email attached data, and the data to be transmitted is the e-mail attachment.

upon arrangement of the device information into attached data and email data, transmitting a single electric mail containing both the attached data and the mail data to said managing device in a state in which specific information cannot be accessed easily;

Patterson, column 3, lines 42-54. Patterson transmits an e-mail attachment to the recipient. The transmission of the e-mail attachment requires, in the same email, header and body data indicating the recipient of the information,—e.g. the mail data to said managing device. Because the e-mail is an attachment, it is not normally readable in a typical e-mail client without the use of a general e-mail plug-in, or the email attachment is by default *in a state in which specific information cannot be accessed easily*.

18. Motoyama failed to disclose a system where data was selected to be sent either as an email or as an attachment within the email. Motoyama did disclose how urgency was important in getting emails to the service provider. Motoyama, column 3, lines 1-7. Patterson disclosed that the use of the Patterson attachment system was ideal for reducing the burden and time required to process business requests for data during business hours. Patterson column 5, lines 27-39. It would have been obvious to one of ordinary skill in the art at the time of invention to use the Patterson email attachment system with Motoyama in order to expediently transmit the data from the business

device in order to alert the manager of the copier problems, without experiencing transmission delays from normal business computer usage.

19. In regard to claim 10, Motoyama disclosed *a recording medium storing a computer program for information communication for notifying a managing device of device information collected regarding a management target device by electric mail, wherein:* (Motoyama, column 6, lines 21-24, column 7, lines 16-30))

on-going selection of information being performed by the information selecting portion provided in the device and the selected information being sent. (Motoyama, column 14, lines 21-40, status updates of whether data is urgent or non-urgent and should be transmitted)

Motoyama failed to disclose *said information communication includes the steps of selecting local to the target device which of the collected device information is to be converted into attached data, and converting the collected device information into both attached data and mail data, in accordance with said selecting and, upon arrangement of the device information into attached data and email data, transmitting a single electric mail containing both the attached data and the mail data to the managing device in a state in which specific information cannot be accessed easily;*

However, Patterson disclosed *said information communication includes the steps of selecting local to the target device which of the collected device information is to be converted into attached data, and converting the collected device information into both attached data and mail data, in accordance with said selecting and, upon arrangement of the device information into attached data and email data, transmitting a single electric*

mail containing both the attached data and the mail data to the managing device in a state in which specific information cannot be accessed easily;

Patterson transmitted the selected electronic content. The content may be transmitted as an e-mail attachment. Patterson, column 3, lines 42-54. Here, the mail data would be the data indicating the recipient of the email attached data, and the data to be transmitted is the e-mail attachment.

Patterson, column 3, lines 42-54. Patterson transmits an e-mail attachment to the recipient. The transmission of the e-mail attachment requires, in the same email, header and body data indicating the recipient of the information,—e.g. the mail data to said managing device. Because the e-mail is an attachment, it is not normally readable in a typical e-mail client without the use of a general e-mail plug-in, or the email attachment is by default *in a state in which specific information cannot be accessed easily*.

20. Motoyama failed to disclose a system where data was selected to be sent either as an email or as an attachment within the email. Motoyama did disclose how urgency was important in getting emails to the service provider. Motoyama, column 3, lines 1-7. Patterson disclosed that the use of the Patterson attachment system was ideal for reducing the burden and time required to process business requests for data during business hours. Patterson column 5, lines 27-39. It would have been obvious to one of ordinary skill in the art at the time of invention to use the Patterson email attachment system with Motoyama in order to expediently transmit the data from the business

device in order to alert the manager of the copier problems, without experiencing transmission delays from normal business computer usage.

21. In regard to claim 33, Motoyama further disclosed

said attached data is produced by a dedicated program, whereby said attached data is readable only by said dedicated program. Motoyama allowed a user to transmit data in a predetermined format. Column 14, lines 16-20. The transmission of data in a predetermined format such as Excel was readable only by a "dedicated program" such as Excel.

22. In regard to claims 36-39, Motoyama failed to explicitly disclose selecting whether data was to be an email attachment or within the email at the target device. Motoyama disclosed a management system which set status messages from a device to a server by use of electronic mail. Motoyama, column 14, lines 1-53. Motoyama disclosed data was in a predetermined format such as Excel or HTML. Motoyama, column 14, lines 16-20. Attachments were used in the email messages. Motoyama, column 17, lines 58-63. Motoyama disclosed using a command to collect device information in column 18, lines 1-62. Attachments were used in email in Motoyama, column 17, lines 58-63.

23. Motoyama failed to disclose a system where data was selected to be sent either as an email or as an attachment within the email. Motoyama did disclose how urgency was important in getting emails to the service provider. Motoyama, column 3, lines 1-7. Patterson disclosed that the use of the Patterson attachment system was ideal for

reducing the burden and time required to process business requests for data during business hours. Patterson column 5, lines 27-39. It would have been obvious to one of ordinary skill in the art at the time of invention to use the Patterson email attachment system with Motoyama in order to expediently transmit the data from the business device in order to alert the manager of the copier problems, without experiencing transmission delays from normal business computer usage.

24. Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Motoyama in view of Patterson in view of Wong et al. (U.S. Patent No. 6,654,746).

25. In regard to claim 34, Motoyama in view of Patterson failed to disclose the compression of an email attachment. However, Wong in the field of art of email transmission disclosed the ability to transmit a compressed email attachment within a message in column 10, lines 13-27. Therefore it would have been obvious to one of ordinary skill in the art to compress the attachments in Motoyama in view of Patterson as shown by example in Wong in order to reduce internet traffic, bandwidth usage, and packet transfer latency during transmission.

26. Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Motoyama in view of Patterson in view of Vaudreuil (US 5,740,230).

In regard to claim 35, Motoyama in view of Patterson is applied as in claim 1. Motoyama in view of Patterson failed to disclose filtering of "confidential" data from data and attaching it separate from other data in an email message. However, privacy filters and mail filters were well known to one of ordinary skill in the art, and were commonly

used in defense and national security applications to prevent information from being sent in the open. Further, at the time of the invention public key cryptography was commonly used in email and involved transmitting a private key along with mail data to allow a user to decrypt the message. Vaudreuil demonstrates an example of this in column 28, line 63 – column 29, line 7. Seeing that many privacy applications were in existence at the time of the invention to allow for sending confidential data in the private along with mail data in the public, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate such technology into an email management program to prevent proprietary device information and password information from being intercepted by cyber criminals during the transmission of said email messages.

Conclusion

27. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

28. Summers US 6,816,884

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey R. Swearingen whose telephone number is (571)272-3921. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivek Srivastava can be reached on 571-272-7304. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jeffrey R. Swearingen
Examiner
Art Unit 2445

/Jeffrey R. Swearingen/
Examiner, Art Unit 2445